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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/470,216	12/22/1999	DALE F. MCINTYRE	80121F-P	5901

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PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
343 STATE STREET
ROCHESTER, NY 14650-2201

EXAMINER

POND, ROBERT M

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 12/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/470,216

Applicant(s)

MCINTYRE ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 September 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-76 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) Interview Summary (PTO-413) Paper No(s). _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

R sp ns to Am ndm nt

The Applicant amended Claims 1, 10, 17, 20, 34, 44, 53, 59, 62, and 71 corresponding to amended sections of the Specification. All pending Claims, 1-76, were examined in light of the amendment, and remain rejected in this final office action.

Response to Arguments

Applicant's arguments filed 25 September 2002 have been fully considered but they are not persuasive. The crux of the Applicant's arguments in light of the amendment is based on providing a product after reaching predetermined criteria established prior to receipt of the necessary material. This examiner respectfully maintains the position that the invention of Shiota et al. delivers a product to the customer based on predetermined criteria established prior to receipt of the necessary material. The predetermined criteria is established by the system and method of Shiota et al. in that the customer submits order information to have a roll of film processed as depicted in Figure 2 in return for a product, or rolls of film processed as depicted in Figure 3. in return for a product. Figure 6 (11) depicts a medium being supplied as an alternative to viewing images online as a result of the customer supplying necessary material. Both Shiota et al. and the Applicant's predetermined criteria are dictated to the customer based on either a finite number of rolls of film submitted by the customer or a passing of time. The predetermine criteria of Shiota et al. exists prior to customer submittal whereas

the predetermined condition as disclosed by the Applicant exists at purchase of the promotional kit. Since neither Shiota et al. nor the Applicant's invention provide a product until at least one roll of film is processed, the point in time at which criteria is deemed "predetermined" does not carry weight for examination purposes.

Regarding references to Fuji Photo Film, this examiner was noting the assignee of each patent cited in the office action. As the assignee of each cited patent, Fuji Photo Film owns the system and method disclosed in each patent.

The Applicant argues hindsight regarding the combination of Komiya et al. and Official Notice with Shiota et al. This examiner maintains the position that since the system and method of Fuji Photo Film as disclosed in Komiya et al. seeks to achieve improvements in product quality and teach product recall tracking, sharing the ID information with the networked photographic service of Fuji Photo Film as disclosed by Shiota et al. would provide additional quality data typically sought by a manufacturing organization. Any problems with film quality detected at the print-processing end would automatically be correlated with the roll ID information already stored and being tracked. This is comparable to existing consumer product return systems that match the returned product's serial number and noted defect(s) with the manufacturer's data to ascertain applicable warranties, recall, or exchange policies (e.g. appliances, consumer electronics, cameras).

Regarding London Drug, this collection of prior art (Items U and V) teaches competitive services offered by London Drug, Fuji Photo, and Kodak. This examiner finds these articles that disclose a unique technical feature offered by London Drug to be relevant prior art since the article is about servicing customers who want to have their film processed. The London Drug system is cited as being a proprietary service similar to Kodak and Fuji (Photo) systems and thereby provides ample motivation to combine with Fuji Photo prior art.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 1. Claims 1-4, 8, and 9 are rejected under 35 USC 102(e) as being anticipated by Shiota et al., patent number 6,324,521.**

Shiota et al. teach all the limitations of Claims 1-4, 8, and 9. For example, Shiota et al. disclose a system and method of Fuji Photo Film Company of providing customers with a photographic service via a computer network. Shiota et al. teach a fulfillment center managing one or more orders, routing photo processing jobs to minilabs and special laboratories, processing and delivering automatically to the customer a first set of prints, and customers connecting remotely to the service via the Internet for viewing, ordering extra prints or other products and services, and sharing with friends (see at least abstract; Fig. 1 (1, 2, 3, 4, 5); Fig. 6 (36); Fig. 7 (6); col. 1, lines 54-67; col. 2, lines 1-9; col. 2, lines 56-67; col. 7, lines 58-62). Shiota et al. teach image retaining devices comprising one or more rolls of photographic film, creating a first set of prints and then electronically scanning and converting into digital images for online viewing (see at least Fig. 1 (7); col. 2, lines 33-41), storing digital images in databases (see at least Fig. 6 (33, 34, 38, 40); col. 10, lines 65-67; col. 11, lines 1-12), and automatically providing a product after reaching a predetermined criteria (col. 9, lines 40-52, col. 10, lines 4-29). Registration information for an order comprises a reception number unique to the order, a processing number unique to the service requested for the images being supplied, and a plurality of image numbers or image identification (ID) numbers, each being unique to the associated digital image (see at least Fig. 2; col. 3, lines 31-35). Shiota et al. teach the use of a web browser plug-in to facilitate browsing and image viewing, and processing application software to manipulate images prior to ordering goods or service.

Shiota et al. teach services and goods such as outputting prints, extra prints, picture postcard, and compact disc (CD) (see at least Fig. 6 (11); col. 10, lines 54-58), generating pass codes for online access, and arrangements or images in an album (see at least col. 4, lines 28-42). Shiota et al. further teach ordering information comprising one or more formats (see at least Figs. 2; col. 6, lines 46), of which the format in Fig. 2 discloses a unique reception number that is used as a registration number for an image retaining device, each image retaining device number comprising at least one image identified by an image number. Shiota et al. further disclose an hierarchical approach to order information processing (see at least Fig. 3; col. 6, line 47) whereby in Fig. 3 Order Information 1 represents ordering information for the first image retaining device, Order Information 2 represents the ordering information of the second image retaining device, and etc., whereby the print order file comprises a group or subgroups associated with a print order.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5-7, 10-60, and 62-76 are rejected under 35 USC 103(a) as being unpatentable over Shiota et al., patent number 6,324,521, in view of London Drug (a collection of articles cited in PTO-892 Items: U and V), and further in view of Komiya et al, patent number 6,155,025, and Official Notice.

Shiota et al. teach all the above as noted under the 102(e) rejection and further teach use of photographic film, photographic film having an image ID number for each image on the film roll, a processing number that pertains to the type of service or services to be performed, a unique reception number to track the order, and an access code for Internet access, but do not specifically disclose how the reception number is generated or its association with a roll of film.

London Drug teaches a photo service providing digital photo finishing by loading customer photos to the Internet. At London Drug, a customer's roll of film is processed into prints, each individually checked for quality, securely loaded to the Internet web site, and optionally loaded into a private album. London Drug emails a personal roll ID code to the customer that creates a hot link directly connecting the customers' e-mail to the London Drug web site. Using the personal roll ID code assigned to each roll of film, a customer and their family or friends can retrieve the photographs from anywhere in the world over the Internet (see Item U, page 1). London Drugs further teaches London Drug's Photo Station, Fuji's Picture Plus, and Kodak's Picture Maker having similar services, and specifically discloses the use of the roll ID to access images over the London Drug web site (see Item V, page 1). Therefore it would have been obvious to one

of ordinary skill in the art at time of the invention to modify the system and method of Shiota et al., to assign unique ID numbers to each roll of film as taught by London Drug, in order to associate one or more roll ID numbers with an Internet posting service or optional album posting, and thereby provide better image management and convenience for customers.

Shiota et al. and London Drug teach all the above as noted under the 103(a) rejection and further teach customer ordering convenience, issuing unique roll IDs to customers to facilitate convenience, and checking for quality during print processing, but do not disclose a) providing roll IDs based on the roll ID supplied with the roll of film, b) associating multiple rolls of film with the package ID during registration, and c) photographic service receiving roll IDs into a database.

Komiya et al. teach a system and method of Fuji Photo Film Company packaging photographic film comprising individually packaged roll of film and multiple rolls of film packaged in a single package. Komiya et al. teach each packaged roll of film having a unique ID number printed on the film, the cartridge, and the package.

Komiya et al. further teach packaging containing multiple rolls as having a package ID that relates to each roll ID in the package, a central production information management system that retains ID information for quality and historical tracking purposes, detecting quality failures after film product is sold, and using ID information to effect recalls (see at least abstract; Fig. 2 (10, 14b, 32, 26, 40a, 40b); Fig. 21 (306b, 310b); col. 9, line 66 through col. 10, line 27; col. 11, lines 18-25; col. 16, lines 48-64; col. 20, lines 36-47; col. 22, lines 22-64).

Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Shiota et al. and London Drug to package roll IDs as taught by Komiya et al., in order to provide added customer ordering convenience, and thereby attract more customers to the service.

Shiota et al., London Drugs, and Komiya et al., teach all the above as noted under the 103(a) rejection, however, do not disclose transmitting roll and package ID information to its networked photographic service. This examiner takes the position that since Komiya et al. seek to achieve improvements in product quality and teach product recall tracking, sharing the ID information with the Fuji Photo Film networked photographic service would provide additional quality data typically sought by a manufacturing organization. Any problems with film quality detected at the print processing end would automatically be correlated with the roll ID information already stored and being tracked.

Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Shiota et al., London Drug, and Komiya et al. to share roll and package ID information as taught by Official Notice, in order to improve product quality by tracking defective product.

- 3. Claim 61 is rejected under 35 USC 103(a) as being unpatentable over Shiota et al., patent number 6,324,521, London Drug (a collection of articles cited in PTO-892 Items: U and V), Komiya et al., patent number 6,155,025,**

and Official Notice , as applied to Claim 59, and further in view of Egan, patent number 6,273,986.

Shiota et al., London Drug, Komiya et al. and Official Notice teach all the above as noted under the 103(a) rejection and further teach printing unique film roll IDs on packages, but do not disclose a removable label that hides the ID. Egan teaches composite labels, package labeling systems and methods where the composite label serves as a combination of shipping label and packing list label with the shipping bar code indicia or other suitable indicia used for tracking purposes and identifying the contents of the package noted on the packing list (see at least abstract; col. 2, lines 32-36; col. 4, lines 18-22). The user removes the shipping label to reveal the packing list that identifies package contents (see at least col. 3, lines 22-51). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Shiota et al., London Drug, Komiya et al. and Official Notice to incorporate a removable label with hidden indicia as taught by Egan, in order to hide the unique roll ID from everyone other than the customer who purchased the film product.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

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Washington D.C. 20231

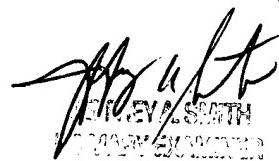
or faxed to:

703-305-7687 (Official communications; including After Final
communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA, 7th floor receptionist.

RMP

December 3, 2002



JENNIFER A. SMITH
USPTO EXAMINER